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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,704	03/23/2004	Toni Kopra	872.0179.U1(US)	2410
29683 7590 08/21/2007 HARRINGTON & SMITH, PC 4 RESEARCH DRIVE SHELTON, CT 06484-6212			EXAMINER GELIN, JEAN ALLAND	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 08/21/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/806,704

Applicant(s)

KOPRA ET AL.

Examiner

Jean A. Gelin

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23,32 and 33 is/are rejected.
- 7) ☒ Claim(s) 24-31 and 34-36 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/22/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1 and 15 lack the proper preamble necessary for a statutory computer program product claim. See MPEP 2100 for guidance on computer related inventions.

Claims 2-14 and 16-22 are also non-statutory because they depend on claims 1 and 15.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-6, 15-18, 20-23, 32, and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Ohmura et al. (US 6,937,732).

Regarding claims 1, 15, Ohmura teaches a first set of computer instructions to display a plurality of identifiers each associated with a digital media file (i.e., displaying

the control content of the audio apparatus and music source music title data, figs. 9-11), wherein a first identifier indicates that a first media file associated with the first identifier is stored within the MS (i.e., audio apparatus corresponding to MS can retrieve best hits music in this week and store them for listening, col. 17, line 23 to col. 18, line 52), and a second identifier indicates that a second media file associated with the second identifier is stored at a location other than within the MS (i.e., to reduce the volume of information storage of the audio apparatus 100, it is possible store music in the external portable apparatus 200, col. 21, lines 1-21).

Regarding claim 2, Ohmura teaches the identifier comprises a media file title and the first and second identifier are distinguished by at least one of: a different font of said title, a different color of said title, a different shade of said title, and a different icon displayed adjacent to the title (figs. 7, 9-11).

Regarding claim 3, Ohmura teaches a second set of computer instructions to establish a connection to a database and copy the second media file to the MS in response to a user input (col. 20, lines 59-67).

Regarding claim 4, Ohmura teaches the database comprises a server on a network, and the connection from the mobile station to the server is via a personal computer to which the mobile station is electronically coupled (cols. 17-18 and 24).

Regarding claim 5, Ohmura teaches the second identifier indicates that a second media file associated with the second identifier is stored within a PC and is not stored within the MS, and the first set of computer instructions further display a third identifier

that indicates that a third media file associated with the third identifier is not stored within the MS or the PC (cols. 17-19 and 23-24).

Regarding claims 6, 20, Ohmura teaches the second set of computer instructions initiates a local connection to the PC to upload the second media file when the corresponding user input selects the second identifier (cols. 17-19), and initiates a mobile telephony connection to a media service server to download the third media file over a data communications network when user input selects the third identifier (cols. 17-19 and cols. 23-25).

Regarding claim 16, Ohmura teaches a fourth set of computer instructions to enable a user to create and edit a playlist of media identifiers stored within the host device without regard to whether a media file associated with a particular music identifier is stored within the host device (cols. 18 and 19).

Regarding claim 17, Ohmura teaches a fifth set of computer instructions to synchronize music files and playlists between the host device and a personal computer, wherein a media file deleted from the host device is not automatically deleted from a separate device selectively coupled to the host device via a local link (cols. 16-18).

Regarding claim 18, Ohmura teaches the second set of computer instructions is to upload, over a local connection from a separate device, and store a database of identifiers each associated with a media file that is stored in the separate device (cols. 17-19).

Regarding claim 21, Ohmura teaches all the limitations above. Ohmura further teaches the database of identifiers is a subset of all identifiers stored at said server, said subset defined by at least one user preference (cols. 17-19).

Regarding claim 22, Ohmura teaches all the limitations above. Ohmura further teaches the host device is a mobile station (corresponding to audio apparatus 100 having cellular telephone 27, col. 7, line 39 to col. 8, line 35).

Regarding claim 23, Ohmura teaches mobile station (audio apparatus 100) comprising: an internal storage media to store a first plurality of media files and a second plurality of file names (i.e., various storage media CD, MD, memory card, col. 10, lines 16-54); a processor coupled to the internal storage media to map each of the first plurality of media files to a file name (i.e., having a CPU to process audio file, col. 8, lines 56-67); and a display interface coupled to the processor to display a series of file names (i.e., displaying the contents, col. 8, line 56 to col. 9, line 9), such that each file name that is mapped to a media file of the first plurality is displayed with a first characteristic and each file name that is not mapped to a media file of the first plurality is displayed with other than the first characteristic (col. 12, lines 22-67).

Regarding claim 32, Ohmura teaches a receiver to receive one of an additional file name over a wireless link, said processor further to update said mapping to reflect the additional file name and said display interface to display said additional file name with one of the first characteristic and the other than the first characteristic, consistent with the processor mapping (cols. 18-23).

Regarding claim 33, Ohmura teaches said additional file name is within a playlist of additional file names received over the wireless link, said processor to update for each file name within the playlist and said display interface to display each file name within the playlist with one of the first characteristic and the other than the first characteristic, consistent with the processor mapping (cols. 18-24).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12-14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohmura in view of Kim (US 6,879,843).

Regarding claims 12, 19, Ohmura teaches all the limitations above except the second identifier indicates that the second media file associated with the second identifier is stored within a PC that has previously been synchronized to the MS.

However, the preceding limitation is known in the art of communications. Kim teaches a means for enabling the mobile station to store and reproduce the MP3 music file downloaded from a personal computer so that the user may enjoy the MP3 player file (col. 5, line 56 to col. 6, line 24). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the technique of Kim within the system of Ohmura in order to connect a mobile station for downloading MP3

digital audio data which was previously downloaded from the Internet to a hard disk on a personal computer. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the technique of Kim within the system of Ohmura in order to selectively reproduce the MP3 audio data stored in the memory of the mobile station as desired at the mobile station.

Regarding claim 13, Ohmura in view of Kim teaches all the limitations above. Kim further teaches the plurality of identifiers include a third identifier that indicates that a third media file associated with a third identifier is stored in both the MS and within a PC that has been coupled to the MS via a local link (i.e., audio file stored in the memory of the computer (PC) is downloaded to the mobile station, and the mobile station can selectively download audio file from the CD or Internet via the PC, col. 5, line 12 to col. 6, line 29).

Regarding claim 14, Ohmura teaches all the limitations above. Kim further teaches the plurality of identifiers include a fourth identifier that indicates that a fourth media file associated with a fourth identifier is not stored in the MS or in a device separate from the MS and linked thereto via a local link, and is stored in a server linked to the MS via a mobile telephony link (col. 5, line 12 to col. 6, line 29).

#### ***Allowable Subject Matter***

7. Claims 7-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and overcome the 101 rejection above.



8. Claims 24-31 and 34-36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Terao et al.	US 2001/0034714	10/25/2001
Yi et al.	US 2001/0039873	11/15/2001
Ahn et al.	US 2004/0214525	10/28/2004

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean A. Gelin whose telephone number is (571) 272-7842. The examiner can normally be reached on 9:30 AM to 7:00 PM.

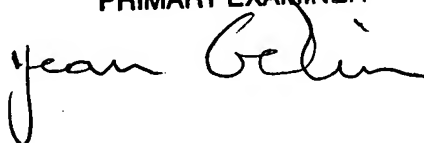
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on (571) 272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JGelin  
August 14, 2007

JEAN GELIN  
PRIMARY EXAMINER

A handwritten signature in cursive script, appearing to read "jean gelin", written in black ink.